UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,859	11/14/2001	Christopher K. Sutton	10003884-1	4778

7590	04/14/2004	

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EXAMINER
KERVEROS, JAMES C

ART UNIT	PAPER NUMBER
2133	

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _18 December 2003_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under _Ex parte Quayle_, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-23_ is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-23_ is/are rejected.

7)☒ Claim(s) _1-13_ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _14 January 2001_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _4,5_.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities:

The specification lacks enablement, because it does include a description for the limitation of "an electronic device under test (DUT) that is separate and distinct from the test system" recited in the independent claims 1, 3, 7, 10 and 14.

Appropriate correction is required.

Claim Objections

Claims 1-13 are objected to because of the following informalities:

Claims 1, 3, 7 and 10, which are directed to an electronic test system, appear to include method steps.

Claim 1, "electronic memory storing steps" should be changed to "electronic memory for storing steps".

Claims 3, 7, 10, "said electronic memory also storing steps" should be changed to "said electronic memory includes storing steps for controlling".

Claim 8, "at different ones" should be changed to " at different levels".

Claims 2, 4-6, 9 and 11-13 are also objected because they depend upon objected claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification lacks enablement, because the specification does include a description for the limitation of "an electronic device under test (DUT) that is separate and distinct from the test system" recited in the independent claims 1, 3, 7, 10 and 14. On page 5, lines 4-6, the specification describes "the test is controlled by processor 102, which communicates the instructions of the test program to the product under test or device under test (DUT) 108 via electrical line 116". If that is the case, then the DUT is connected to the test system. A person skilled in the art would not be able to test the DUT as long it is separate and distinct from the test system.

Claims 2, 4-6, 8, 9, 11-13 and 15-23 are also rejected because they depend upon rejected claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 7 and 10, the phrase "tape recorder type" renders the claims indefinite because the claims includes elements not actually disclosed, such as those encompassed by "type", thereby rendering the scope of the claim(s) unascertainable. Furthermore, the "control buttons" recited in the claims are part of a display control interface for communicating with an electronic processor relating to testing, which has nothing to do with a tape recorder. See MPEP § 2173.05(d).

Claims 8, 9 and 11-13 are also rejected because they depend upon rejected claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Peter et

al. (US 6418389), FILED: August 2, 1999.

Regarding Claims 1, 3, 7, 10, 14, Peter discloses an electronic test system and

method for testing the operability of device under test (DUT), comprising:

An electronic memory (central databank, 3) which serves for the storing and the

overall administration over test modules of all test sample related data to be performed

on an electronic device under test (DUT) such as (test sample, 7) that is separate and

distinct from the test system, FIG. 1.

An electronic processor (control module, 1) communicating with the memory

central databank (3) for controlling the execution of the electronic test;

A control interface such as graphical user interface (GUI) FIGS 4 and 5, for

communicating with the electronic processor (1, FIG. 1), where the control interface

(GUI) includes at least four buttons grouped adjacent to one another via a menu bar

21, which makes available the usual menu commands for Windows applications. Via

the menu selection "test" the test in accordance with the produced test specification

can be started, halted, broken off, or continued, (col. 9, lines 15-25).

A graphical element (icon/symbol) associated with each of the buttons above

conveys a command for controlling the test, as shown in menu bar 22 located beneath

menu 21, where there are represented buttons for the more significant menu

commands, which thus make possible a simplified access to the important menu

commands. Further, there are setting fields or formatting buttons 23 which in particular

serve for the formatting of an input text or of an embedded graphic.

In addition to the common features applied to claim 1 above, Peter discloses a display (12) communicating with the electronic processor (1) to display information including a control interface such as graphical user interface (GUI) comprising a plurality of icons, FIGS 4 and 5, and an input device and input device (9) such as a keyboard or a mouse, for interacting with the control interface (GUI) and the processor (1) to enable a user to control the test, as recited in the independent claims 3, 7, 10 and 15. Further, Peter discloses four buttons corresponding to four test functions such as run (started), pause and stop (halted), abort and skip (broken off), restart (continued), recited in independent claim 10.

Regarding Claim 2, Peter discloses a menu selection "test", with the corresponding test commands, accordingly: abort (broken off), restart (continued), run (started) and pause (halted).

Regarding Claims 4, 15, Peter discloses graphical elements (icon/symbol) associated with each of the buttons above, which includes a label, for example, such as the text "run" (start) corresponding to the function of the test "run" command, where buttons 23 serves for the formatting of the embedded graphic (icon), by inserting for example the text "run" for icon.

Regarding Claim 5, Peter discloses a control interface, such as graphical user interface (GUI) FIGS. 4 and 5, includes icons grouped together.

Regarding Claim 6, Peter discloses four commands or more, such as abort and skip (broken off), run (started), pause (halted), restart and repeat test and repeat measurement (continued).

Regarding Claims 8, 9, 12, 13, Peter discloses an electronic memory (central databank, 3), which serves for storing test data including test and measurement levels, where the test results from the device under test (DUT) are displayed on the display device 12, also shown by the graphical user interface (GUI) FIG. 4B, and where at least two of the buttons, such as run (started) and pause (halted) control the progress of the test.

Regarding Claim 11, Peter discloses four buttons, which can perform test commands corresponding to equivalent five functional buttons, such as run (started), pause and stop (halted), abort and skip (broken off), restart (continued).

Regarding Claims 16-23, Peter discloses a method for controlling the execution of an electronic test comprising the step of engaging a button:

1. "Abort" (broken off) to stop the test execution, in regard to claim 16.

2. "Restart test" (continued) to restart the test execution, in regard to claim 17.

3. "Restart measurement" (continued) to restart the execution of a test measurement, in regard to claim 18.

4. "Pause" (halted) to momentarily halt the test execution, in regard to claim 19.

5. "Skip test" (broken off) to skip the test, in regard to claim 20.

6. "Skip measurement" (broken off) to skip a measurement in the test, in regard to claim 21.

7. "Repeat test" (started) to repeat the test, in regard to claim 22.

8. "Repeat measurement" (started) to repeat a measurement within the test, in regard to claim 23.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to James C Kerveros whose telephone number is (703)

305-1081. The examiner can normally be reached on 9:00 AM TO 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Albert Decady can be reached on (703) 305-9595. The fax phone number

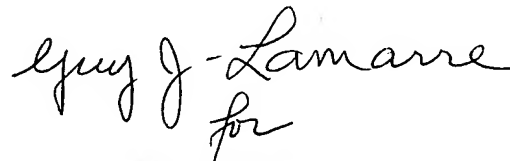for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

U.S. PATENT OFFICE   By:
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Date: 6 April 2004   James C Kerveros
Office Action: Non-Final Rejection   Examiner
                                                       Art Unit 2133

                                                       Albert DeCady
                                                       Primary Examiner